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Paper No. 19

HRW

11/8/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Journey Education Marketing, Inc.

Serial No. 75/058,829

Dennis T. Griggs of Griggs & Johnston, L.L.P.
for Journey Education Marketing, Inc.

Catherine K. Krebs, Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Cissel, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Journey Education Marketing, Inc. has filed an
application to register the mark STUDENT SOFTWARE GUIDE for
"distributorships in the field of computer software for
others."¹

Registration has been finally refused on the grounds
that:

¹ Serial No. 75/058,829, filed February 16, 1996, claiming a
first use date and first use in commerce date of October 1992.
The application was subsequently amended to one seeking
registration under the provisions of Section 2(f).

- (1) the proposed mark is merely descriptive under Section 2(e)(1) of the Trademark Act;
- (2) the claim of distinctiveness under Section 2(f) is not supported by the record;
- (3) the proposed mark is generic as applied to the identified services; and
- (4) the proposed mark fails to function as a mark under the provisions of Sections 1, 2 and 45 of the Trademark Act.

The final refusal of registration based on these grounds has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

In all of the outstanding refusals to registration, the Examining Attorney is relying upon the specimens of record, particularly the substitute specimens,² and the manner in which STUDENT SOFTWARE GUIDE is used thereon. These specimens consist of catalogs for software bearing STUDENT SOFTWARE GUIDE as the title on the cover page. Statements throughout the catalog indicate that the prospective purchasers of this software are students; in fact potential purchasers for software at the "student educational pricing" are limited to college students, high

² The original specimens were considered unacceptable by the Examining Attorney, since the words STUDENT SOFTWARE GUIDE only appeared in the advertising material as a part of the phrase "To receive a FREE Student Software Guide, call:" and not separately as a mark.

school students (for most of the software) and faculty and staff. The designation JOURNEY EDUCATION MARKETING appears frequently as the name of the source from which the software may be ordered.³

In her refusal under Sections 1, 2 and 45, the Examining Attorney maintains that the proposed mark does not function as a service mark, but rather merely names or serves as a title for a publication which is used in connection with applicant's services. She argues that in the specimens of record the function of identifying the source of the services is fulfilled by the designation JOURNEY EDUCATION MARKETING. In her view, STUDENT SOFTWARE GUIDE, as used by applicant, fails to function as a service mark because it is merely the name of the software catalog; it neither distinguishes the services of applicant from those of others nor indicates the source of applicant's services.

³ From these specimens, it appears that the present recitation of services does not accurately describe applicant's services. These services are not "distributorships," or "distributorship services," as that term is commonly understood; applicant appears to render retail mail order services. Accordingly, if applicant is successful on an appeal of our decision, the case should be remanded to the Examining Attorney for amendment of the recitation of services to a more accurate description of applicant's services. For purposes of our present decision, we have considered applicant's services as being retail mail order services in the field of computer software, as demonstrated by the specimens.

Applicant contends that it has demonstrated its intent to use STUDENT SOFTWARE GUIDE as a service mark by placing the superscript "TM" adjacent thereto and by submitting a sworn statement of its adoption of the mark to identify its services. Moreover, according to applicant, in view of applicant's distinctive display of the mark in relatively large type on the front page of the catalog, purchasers would recognize STUDENT SOFTWARE GUIDE as an indicator of origin.

Under Section 45 of the Trademark Act, a "service mark" is defined as "any word, name, symbol, or device, or combination thereof (1)used by a person...to identify and distinguish the services of one person...from the services of others and to indicate the source of the services, even if that source is unknown." Implicit in this definition is a requirement that there be a direct association between the mark sought to be registered and the services identified in the application. Whether a designation has been used a service mark must be determined on the basis of the specimens or any other evidence of record. See *In re Moody's Investors Services Inc.*, 13 USPQ2d 2043 (TTAB 1989) and the cases cited therein.

Potential purchasers would simply view STUDENT SOFTWARE GUIDE as the title of a publication or catalog

listing the software which is available to students. There is no direct link between this title, as used on the front of the catalog, and the underlying source of the service of mail order retail sales of the software. This is no apparent reason for purchasers to view the title of the catalog as a service mark for applicant's services. The mere size of the title is irrelevant. Furthermore, whether or not applicant intends that the title be viewed as a service mark does not make it happen.⁴ The manner in which potential purchasers encounter STUDENT SOFTWARE GUIDE, as evidenced by the specimens, is the determinative factor. See *In re Morganroth*, 208 USPQ 284 (TTAB 1980). The specimens simply show this designation used descriptively in reference to the catalog, not as an indicator of the source of the services.

We are fully aware that in promoting its retail mail order service, applicant could be expected to issue a catalog advertising its goods. The title of the catalog could well serve as a service mark for the sale of the goods advertised therein. The problem here, however, is that no direct association has been made between the title

⁴ Although applicant may argue that it uses a "TM" designation to demonstrate its intended use as a mark, the specimens show use of a ®, which is not only misleading, but improper. See TMEP § 906.

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of the catalog and the source of the software listed therein. The highly descriptive title of the catalog, STUDENT SOFTWARE GUIDE, has no function other than that; it names the publication. Purchasers must look elsewhere to determine the source of the software listed therein and the service of selling it at retail by means of mail order. In fact, the source is specifically indicated as JOURNEY EDUCATION MARKETING.

Accordingly, we find that the designation STUDENT SOFTWARE GUIDE fails to function as a service mark for the services specified in the application. In the interests of completeness, however, and in the event that our affirmance of this refusal might be overturned on appeal, we have also considered the other refusals. In so doing, we operate under the assumption that STUDENT SOFTWARE GUIDE does function as a mark for applicant's services.

Looking to the refusal under Section 2(e)(1), we note, as pointed out by the Examining Attorney, that applicant has disclaimed the term SOFTWARE GUIDE, thus acknowledging the descriptiveness thereof. As for the word STUDENT, the Examining Attorney relies upon the many references in the specimens of record to students as the prospective purchasers. On the basis of these statements, the Examining Attorney maintains that the term STUDENT merely

describes the primary intended customer of applicant's retail mail order services in the field of computer software.

Applicant's principal argument with respect to the descriptiveness of its mark, as opposed to the issue of genericness, is that the phrase as a whole does not immediately describe the specific nature of applicant's services.⁵

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that the term or phrase describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term or phrase describes a significant attribute thereof. See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). The Board has held a mark merely descriptive if it describes the type of individuals to whom an appreciable

⁵ We are puzzled, as was the Examining Attorney, with applicant's arguments with respect to registration of the mark on the Supplemental Register and the underlying question of capability of functioning as a mark. Applicant amended the application to one seeking registration on the Principal Register under Section 2(f), not on the Supplemental Register.

number or all of a party's goods or services are directed. See *In re Camel Manufacturing Company, Inc.*, 222 USPQ 1031 (TTAB 1984) and the cases cited therein.

Here the term SOFTWARE GUIDE has been disclaimed as descriptive of applicant's services. Moreover, from the content of the catalog or guide, as noted above, it is clear that applicant's services are directed primarily to students. In fact, purchasers have to certify that they qualify as students in order to obtain the educational discounts. The only exception made is for faculty members. Thus, we find the phrase STUDENT SOFTWARE GUIDE as a whole, when used in connection with applicant's services, merely descriptive because a feature of these services is providing a guide to students listing the software applicant sells. There is little left to the potential purchaser's imagination; the information is immediately conveyed that a feature of applicant's services is the student software guide.

We turn next to the refusal on the ground of genericness. A generic term or phrase is by definition incapable of indicating source, and thus can never attain trademark status. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Accordingly, the issue of genericness must be

determined before any consideration can be given to applicant's claim of acquired distinctiveness under Section 2(f).

The test for determining genericness, as set forth in *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 Fed. Cir. 1986), and recently re-affirmed in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), involves a two-step inquiry: 1) what is the genus of goods or services at issue and 2) whether the term or phrase sought to be registered is understood by the relevant public primarily to refer to that genus of goods or services.

Here the genus or category of services at issue is retail mail order services in the field of computer software. The question is whether STUDENT SOFTWARE GUIDE would be understood by the relevant public, namely, the students and faculty who purchase the software, to refer primarily to this genus or category of services, in a generic manner.

The Examining Attorney maintains that the phrase STUDENT SOFTWARE GUIDE is the generic name for a retail sales "tool," namely, a software guide intended for students, and thus is being used in a generic manner when

used in connection with applicant's services. In support of her refusal to register based on genericness, the Examining Attorney has made of record several Nexis excerpts in which the term "software guide" is found in close proximity to the word "student." She argues that these excerpts provide evidence of the use of the term "software guide" as the generic name of a type of publication and of the term "student" as the generic name of the intended user.

The first deficiency in the Examining Attorney's refusal is her failure to produce any evidence of use of the phrase STUDENT SOFTWARE GUIDE in its entirety. The Court made it clear in its *American Fertility* decision, *supra*, that "definitions and generic uses of the constituent terms of a mark ... [cannot be cited] in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark ... generic." 51 USPQ2d at 1836. The Court placed the burden on the Office to establish that the phrase as a whole had no meaning to the relevant public in addition to that of the terms individually; to demonstrate that the phrase, and not just the constituent elements, was generic.

Here, we find no use in any of the Nexis excerpts of the composite phrase "student software guide." Although

there is evidence of the use of the term "software guide," the concurrent references in the same excerpts to "students" are not in direct conjunction therewith. The requirement of the Court in *American Fertility* that there be evidence that the phrase as a whole has been used in a generic manner has not been met. Cf. *In re 3Com Corp.*, 56 USPQ2d 1060 (TTAB 2000)(numerous Nexis excerpts showing generic usage of "ATM link" as a whole).

Even more significantly, even if such evidence were of record, it would not establish that the phrase STUDENT SOFTWARE GUIDE would be understood by the relevant public as a generic reference to the genus or category of services at issue. A generic reference to a particular "tool" used therewith is not the same as a generic reference to the services per se. Accordingly, we cannot uphold the refusal based on genericness.

Thus, we turn to the question of whether applicant has submitted sufficient evidence to support of its claim of acquired distinctiveness under Section 2(f). Applicant's burden of proof is to demonstrate that its use of the merely descriptive designation STUDENT SOFTWARE GUIDE has been such that the designation has acquired distinctiveness as a mark in commerce.

Applicant's original claim of distinctiveness under Section 2(f) was based solely on use of the mark in commerce for at least five years. When the Examining Attorney refused this claim of distinctiveness, in view of the highly descriptive nature of applicant's mark, applicant submitted a supplemental declaration from Michael S. Fischler, President and CEO of applicant. In his declaration made in January 1999, Mr. Fischler attests to use of the mark STUDENT SOFTWARE GUIDE since as early as October 1992; use of the mark in the advertisement of applicant's sale of software in catalogs, magazines, and television advertising, and at trade shows, promotions at colleges and on its web site; advertising expenditures incurred in the marketing of its software products in connection with the use of its mark ranging from \$192,512 in 1992 to \$1,440,000 in 1998; gross software sales advertised and marketed in connection with applicant's mark ranging from \$962,561 in 1992 to \$12,000,000 in 1998; and fees of approximately \$250,000 paid by software companies in 1998 for advertising space in applicant's catalog. Mr. Fischler attached to his declaration samples of promotional materials showing use of the mark, which for the most part are advertisements in magazines showing use of applicant's

mark in connection with the promotion of its free catalog, the STUDENT SOFTWARE GUIDE.

The Examining Attorney was not persuaded by this additional evidence. She argues that evidence that applicant has made large advertising expenditures or that others have advertised in applicant's catalog does not establish acquired distinctiveness for the phrase being used by applicant in connection with its catalog. She insists that applicant's exhibits show use of STUDENT SOFTWARE GUIDE simply as the name of the free catalog which applicant provides in connection with the marketing of its services and that consumers would so regard the phrase, rather than as an identification of applicant as the source of the underlying retail sales services.

As noted above, we agree that the evidence of record shows consistent use by applicant of the phrase STUDENT SOFTWARE GUIDE to describe or name its catalog, not to identify the source of its services. While applicant may have established that it has expended substantial amounts in advertising its services and that it has reaped substantial profits in sales, applicant has failed to demonstrate that it has promoted, or that consumers have come to view, STUDENT SOFTWARE GUIDE as a mark for these services. See *In re Pennzoil Products Co.*, *supra*.

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Applicant's advertising merely touts its free catalog, which is entitled STUDENT SOFTWARE GUIDE. There is no promotion of the term as an indicator of applicant as the source of the software listed therein.

We have found the evidence before us insufficient to establish that the designation would be understood by the relevant public as a generic name for services of the type rendered by applicant. Without evidence of specific promotion and consumer recognition of the designation as a service mark for applicant's services, however, acquired distinctiveness has not been established. See *In re Audio Book Club Inc.*, 52 USPQ2d 1042 (TTAB 1999); *In re Recorded Books Inc.*, 42 USPQ2d 1276 (TTAB 1997). Applicant's evidence is insufficient to support its claim of distinctiveness under Section 2(f).

Decision: The refusal on the ground that the designation STUDENT SOFTWARE GUIDE fails to function as a mark for applicant's services under the provisions of Sections 1, 2, and 45 is affirmed. In addition, the refusal to register on the ground that STUDENT SOFTWARE GUIDE is merely descriptive when used in connection with applicant's services and that the evidence submitted under Section 2(f) is insufficient to establish acquired

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distinctiveness is also affirmed. The remaining refusal on the grounds of genericness is reversed.

R. F. Cissel

T. J. Quinn

H. R. Wendel

Administrative Trademark Judges,
Trademark Trial and Appeal Board

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